# UNITED STATES PATENT AND TRADEMARK OFFICE

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/750,577 | 12/29/2000 | Ephraim Feig | SOM919990022US1(1963-7364 | 6519 |

| 7590 | 03/08/2004 |
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| EXAMINER |
|---|
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| ART UNIT | PAPER NUMBER |
|---|---|
| 2178 | |

DATE MAILED: 03/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *29 December 2000*.

2a)☐ This action is **FINAL**.      2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-29* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-29* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *20 April 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

## DETAILED ACTION

1.  This action is response to application 09/750,577, with no prior art filed.

2.  Claims 1-29 are pending in the case. Claims 1, 8, 16, and 23 are independent claims.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3.  **Claims 1, 4, 16 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by**

    **Bernstein et al. (USPN 5,297,249—filing date 10/31/1990), hereinafter Bernstein.**

4.  **Regarding independent claim 1,** Bernstein discloses a method of managing target files

    referred to by referring documents (see col. 24, lines 25-45), comprising: identifying

    referring documents having a hypertext link pointing to a target document stored in a

    storage (see col. 24, lines 33-35); determining when the referring documents cease to

    have hyperlinks pointing to the target document; (see col. 24, lines 45-50); and enabling

    removing of the target document from the storage (see col. 24, lines 45-55).

5.  **Regarding dependent claim 4,** Bernstein inherently describes an invention wherein the

    referring document uses a hypertext link to point to the target document (see col. 24, lines

    44-55).

6.  **Regarding independent claim 16,** it is a system that performs the method of claim 1 and

    is rejected under similar rationale.

7. **Regarding dependent claim 19,** it is a system that performs the method of claim 4 and is rejected under similar rationale.

8. **Claims 8 and 23 are rejected under 35 U.S.C. 102(a) as being anticipated by Scanlan (USPN 6,029,245—filing date 3/25/1997).**

9. **Regarding independent claim 8,** Scanlan discloses a method of providing security for target files referred to by referring documents (Abstract, lines 1-3), comprising: identifying a first referring document having a hyperlink pointing to a target document stored in a storage, the first referring document having a security access requirement (Abstract, lines 6-10); and applying said security access requirement to the target document (Abstract, lines 10-14).

10. **Regarding dependent claim 23,** it is a system that performs the method of claim 8 and is rejected under similar rationale.

### Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. **Claims 2-3, 5-6, 17-18, and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bernstein.**

12. **Regarding dependent claim 2,** Bernstein fails to disclose that said referring documents and said target document are stored in different storage devices coupled over a network.

However, it was notoriously well known in the art at the time of the invention that

hyperlinks are used over the WWW to permit resource sharing. It would have been

obvious to one of ordinary skill in the art at the time of the invention to have the

hyperlinks span a network to permit resource sharing.

13. **Regarding dependent claim 3,** Bernstein fails to disclose that said referring documents

and said target document are stored in the same storage device. However, it was

notoriously well known in the art at the time of the invention that documents within the

same machine are often linked to facilitate navigation. It would have been obvious to one

of ordinary skill in the art at the time of the invention to link documents within the same

machine to facilitate navigation.

14. **Regarding dependent claim 5,** Bernstein fails to disclose that the storage decrement a

counter for the current document when a referring document is deleted. However, it was

notoriously well known in the art at the time of the invention that maintaining a count of

a class of item helps to determine when that class of item has been entirely removed. It

would have been obvious to one of ordinary skill in the art at the time of the invention to

help determine when the references have been entirely removed.

15. **Regarding dependent claim 6,** Bernstein fails to disclose the step of determining

whether the count for the counter of the target document equals zero. However, it was

notoriously well known in the art at the time of the invention checking a count of

references to see if it is zero is a good way to see if there are any references remaining,

which allows successful removal of extra files. It would have been obvious to one of

ordinary skill in the art at the time of the invention to check a count of references to see if

it is zero to allow successful removal of extra files.

16. **Regarding dependent claim 17,** it is a system that performs the method of claim 2 and is

rejected under similar rationale.

17. **Regarding dependent claim 18,** it is a system that performs the method of claim 3 and is

rejected under similar rationale.

18. **Regarding dependent claim 20,** it is a system that performs the method of claim 5 and is

rejected under similar rationale.

19. **Regarding dependent claim 21,** it is a system that performs the method of claim 6 and is

rejected under similar rationale.

20. **Claims 7 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over**

**Bernstein, further in view of Banning et al. (USPN 5,421,008—filing date 11/8/1991),**

**hereinafter Banning.**

21. **Regarding dependent claim 7,** Bernstein fails to disclose that if the counter equals zero,

then the steps comprising: sending a message to an author of the target document asking

whether the autho client wants to delete the target document from the storage. However,

Banning, in col. 29, lines 59-68 offers a dialog box that allows the user to regulate

deletion in order to provide the user with control over the deletion process. It would have

been obvious to one of ordinary skill in the art at the time of the invention to allow the

user to regulate deletion in the manner of Banning in the invention of Bernstein in order

to provide the user with control over the deletion process.

22. **Regarding dependent claim 22,** it is a system that performs the method of claim 7 and is rejected under similar rationale.

23. **Claim 9-12 and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scanlan.**

24. **Regarding dependent claim 9,** Scanlan discloses determining whether a second referring document has said security access requirement; and preventing said second referring document from accessing said target document document if said second referring document does not have said security access requirement. (This is an inherent implication of the security privileges disclosed in the Abstract, lines 1-15). However, Scanlan does not explicitly disclose identifying a second referring document having a hyperlink pointing to the target document stored in a storage. However, it was notoriously well known in the art at the time of the invention that one may create documents with hyperlinks pointing to other documents and with access privileges in order to relate documents to each other in a secure manner. It would have been obvious to one of ordinary skill in the art at the time of the invention to create documents with hyperlinks pointing to other documents and with access privileges in order to relate documents to each other in a secure manner.

25. **Regarding dependent claim 10,** it is a method that modifies claim 9 in a manner analogous to the manner in which claim 2 modifies claim 1, and may be rejected under similar rationale.

26. **Regarding dependent claim 11,** it is a method that modifies claim 9 in a manner analogous to the manner in which claim 3 modifies claim 1, and may be rejected under similar rationale.

27. **Regarding dependent claim 12,** it is a method that modifies claim 9 in a manner analogous to the manner in which claim 4 modifies claim 1, and may be rejected under similar rationale.

28. **Regarding dependent claim 24,** it is a system that performs the method of claim 9 and is rejected under similar rationale.

29. **Regarding dependent claim 25,** it is a system that performs the method of claim 10 and is rejected under similar rationale.

30. **Regarding dependent claim 26,** it is a system that performs the method of claim 11 and is rejected under similar rationale.

31. **Claims 13-14 and 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scanlan, further in view of Bernstein.**

32. **Regarding dependent claim 13,** it is a method that modifies claim 9 in a manner analogous to the manner in which claim 5 modifies claim 1, and may be rejected under similar rationale.

33. **Regarding dependent claim 14,** it is a method that modifies claim 13 in a manner analogous to the manner in which claim 6 modifies claim 5, and may be rejected under similar rationale.

34. **Regarding dependent claim 27,** it is a system that performs the method of claim 13 and is rejected under similar rationale.

35. **Regarding dependent claim 28,** it is a system that performs the method of claim 14 and is rejected under similar rationale.

36. **Claims 15 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scanlan, further in view of Banning.**

37. **Regarding dependent claim 15,** it is a method that modifies claim 14 in a manner analogous to the manner in which claim 7 modifies claim 6, and may be rejected under similar rationale.

38. **Regarding dependent claim 29,** it is a system that performs the method of claim 2 and is rejected under similar rationale.

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

USPN 6,321,242 B1 (filng date 2/6/1998)—Fogg et al.

USPN 5,204,947 (filing date 10/31/1990)—Bernstein et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan D. Schlaifer whose telephone number is 703-305-9777. The examiner can normally be reached on 8:30-5:00, M-F.
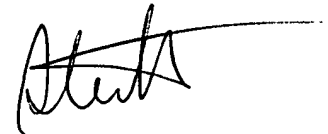
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 703-308-5186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

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system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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